Remarks

This Amendment is in response to the Office Action dated **April 22, 2004.** Claims 30-42 are pending in this application. The Office Action rejected claims 30-42 under the doctrine of obviousness-type double patenting over claims 1-16 of US 6617005; rejected claim 37 under 35 USC § 102 over Edwards et al. (US 5239800; hereinafter "Edwards"); and rejected claims 38-42 under 35 USC § 103 over Edwards in view of Quarles (US 5531427).

By this Amendment, claims 37 and 38 are amended and a terminal disclaimer is submitted to obviate the double patenting rejections. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Allowable Subject Matter

Applicant gratefully acknowledges the Office Action's indication of allowable subject matter in claims 30-36. However, for the reasons set forth below, Applicant respectfully asserts that all of the claims are directed to allowable subject matter and that the application is in condition for allowance.

Claim Rejections based on obviousness type double patenting

The Office Action rejects claims 30-36 under the judicially created doctrine of obviousness type double patenting over claims 1-16 of US 6617005. A Terminal Disclaimer directed to US 6617005 is enclosed herewith. Applicant believes that the enclosed Terminal Disclaimer fully resolves the rejection raised by the Examiner and complies with 37 CFR § 1.321(c). Accordingly, Applicant requests withdrawal of the rejections.

Claim Rejections – 35 USC §§102 and 103

The Office Action rejects, under 35 USC § 102, claim 37 over Edwards (US 5239800). The Office Action also rejects, under 35 USC § 103, claims 38-42 over Edwards in view of Quarles (US 5531427). Independent claims 37 and 38 have been amended.

With respect to 35 U.S.C. §102, the Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756

F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); *Atlas Power Co. v. E.I. DuPont DeNemours*, 750 F.2d 1569, 24 U.S.P.Q. 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 U.S.P.Q. 577 (Fed. Cir. 1984).

Applicant asserts that Edwards does not disclose or suggest "a non-metallic frame" as recited in claim 37, and similarly recited in claim 38.

Edwards discloses a file cabinet door of sheet metal construction. See column 2, lines 18-19. Edwards does not disclose or suggest any materials that could be substituted for the sheet metal.

Therefore, Applicant respectfully submits that independent claim 37 is not anticipated by Edwards because Edwards fails to teach every limitation of the claim as required by 35 USC § 102. Accordingly, Applicant requests withdrawal of the rejection under 35 USC § 102.

With respect to independent claim 38 as amended and the rejections under 35 USC § 103, Applicant asserts that the combination of Edwards in view of Quarles does not disclose or suggest all of the limitations of claim 38, and further, there is absolutely no motivation to modify the references to arrive at claim 38 absent the use of hindsight.

As discussed above, Edwards discloses sheet metal, and does not disclose or suggest any materials that could be substituted for sheet metal. Quarles discloses a metallic fence system. See column 3, lines 6-7. Quarles teaches away from the use of other materials, such as wood, in the fence system. See column 3, lines 8-9. Quarles does not disclose or suggest any other materials or provide any motivation to modify Edwards to arrive at "a non-metallic frame" as recited in claim 38.

The references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 488 (Fed. Cir. 1984)). The references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

When an attempt is made to combine two references A and B, or to change a single reference, a prima facie case of obviousness has not been established if A and B could not

or would not be physically combined in an operative fashion to produce the desired result by a person of ordinary skill without use of the patentee's teachings. *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972); *In re Regel*, 526 F.2d 1399, 199 USPQ 136 (CCPA 1975); *In re Jansson*, 609 F.2d 996, 203 USPQ 976 (CCPA 1979).

Applicant asserts that the combination of Edwards in view of Quarles does not render claim 38 obvious absent the use of hindsight by reading "a non-metallic frame" into at least one of the references.

Therefore, Applicant asserts that independent claim 38 is not obvious over Edwards in view of Quarles. Claims 39-42 depend from independent claim 38 and therefore are not obvious for at least the reasons discussed with respect to claim 38. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 USC § 103.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 30-42 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: July 22, 2004

By: _____
Jeremy G. Laabs
Registration No.: 53170

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

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